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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/616,950
Filing Date: 7/11/20031
Appellant(s): GEWHR ET AL

James Remenick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 28, 2006 appealing from the Office action mailed February 28, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. No status has been cited which claim is canceled, original or amended.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following rejection is not presented for review on appeal because the examiner has withdrawn them.

Rejection of claims under 35 U.S.C. 103(a) as being unpatentable over CURTZE et al. (US Patent No. 6127570) is withdrawn because declaration has been filed.

(7) Claims Appendix

Claims 1, 2, 4 and 5 contain(s) substantial errors as presented in the Appendix to the brief. Claims as written do not show the status of each claim, for example, amended, original or cancelled. Claim 3 has been cancelled.

(8) Evidence Relied Upon

6,696,497	SIEVERDING et al.	2-2004
6,521,628	COTTER et al	2-2003
6,734,202	COTTER et al.	5-2004
6,127,570	CURTZE et al.	10-2000

(9) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,696,497. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the US ' 297 are considered obvious since the term "comprising" is used in the instant invention.

The term "comprising" allows other additional components to be added. Instant claims are obvious because compound of formula (1) in claim 1 contains the same substituents.

Claim 1 of present application overlaps claim 1 of US '497 because at 5-position of benzophenone ring contain halogen wherein US '497 it is bromine (Br). Claims 2 and 4 of the present invention is same as in claim 1 of compound (a) of US '497. Method claimed in claim 1, 2 4 and 5 for controlling *Pseudocercosporella herpotrichoides* in wheat and barley overlaps with the method of claim 4 and 5 of US Patent '497.

The patent claims composition and method of controlling fungi by using 5-bromo 6-dimethyl-2,4',5',6'-tetramethoxybenzophenone.

The instant claims differ from the claims of the cited US Patents in that US '497 claims specific second components for the fungicidal composition and method for controlling fungi. In the instant claims, a specific second ingredient has not been named. However, the term "comprising" allows a second ingredient to be added. The method of claim 4 is for "controlling growth of fungi" which includes *Pseudocercosporella herpotrichoide.*

Therefore, the instant invention is considered obvious over the claims of the cited US Patent '497.

(10) Response to Argument

- Appellant's argument and declaration filed on January 19, 2007 has been fully considered and was found persuasive therefore rejection of claims under 35 U.S.C. 103(a) as being unpatentable over CURTZE et al. (US Patent No. 6,127,570) is withdrawn.
- Appellants argue that second component (b) is specific which is not claimed in the present application. Examiner disagrees because he term "comprising" allows the addition of other ingredients. The compounds of US'497 is same as presently claimed. A method of claim 4 is for "controlling growth of fungi" which includes *Pseudocercosporella herpotrichoide.*
- Terminal disclaimer has been filed for U.S. Patent No. 6,521,628 and U.S. Patent No. 6,734,202 therefore double patenting rejection was withdrawn. DP rejection over US Patent 6,696,497 is maintained because no disclaimer has been filed.

- Appellants argue that second component (b) is specific which is not claimed in the present application. Examiner disagrees because the term "comprising" allows the addition of other components. The compounds of US'497 is same as presently claimed. A method of claim 4 is for "controlling growth of fungi" which includes *Pseudocercosporella herpotrichoide.*

- Double Patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

- Examiner notes, that Terminal Disclaimer has been filed on US '202 and "628. Both of them contain a second specific component as in US '497.

- Even in a case where the reference does not teach the same use of the composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau,* 57 USPQ 324; *Ex parte Douros,* 163 USPQ 667; and *In re Craige,* 89 USPQ 393.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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